

Attorney Docket No. P31939-03

## IN THE UNITED STATES AND TRADEMARK OFFICE

In re Application of IKEDA et al.

Customer No: 42212

Application No. 10/528,969

Art Unit: 2621

Patent No.: 7,639,923

Examiner: Zhao

Filing Date: Oct. 3, 2005

Title: **REPRODUCTION DEVICE, OPTICAL DISC...****REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT (AND/OR PETITION) UNDER 37 C.F.R. 1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The applicant requests reconsideration of the term adjustment for the above-identified patent application.

**A. Fee**

The fee of \$200.00 per 35 CFR 1.18(e) is submitted herewith.

**B. Statement of the Facts**

1. The issue notification of **December 9, 2009** included a Determination of Patent Term Adjustment) indicated a patent term adjustment of **498** days.
2. The patent was issued on **December 29, 2009**. This request/petition is being filed within two months of the date issue.

3. On January 7, 2010, the United States Court of Appeals for the Federal Circuit affirmed the District Court of decision regarding the PTO's interpretation of 35 USC §154. See Wyeth and Elan Pharma v. Kappos (Fed. Cir., 2009)<sup>1</sup>.
4. The present request for reconsideration raises issues that could not have been raised in an application for patent term adjustment under paragraph (b) of this section because Wyeth was decided after the issue fee was paid.
5. The present application was filed on October 3, 2005 and the first Office Action was mailed on June 10, 2008, whereby the delay under CFR §1.702(a)<sup>2</sup> (the "A" delay) is 555 days.
6. The patent application was filed October 3, 2005 and the patent was issued on December 29, 2009; however, a Request for Continued Examination (RCE) was filed on December 18, 2008. Therefore, the delay under CFR §1.702(b)<sup>3</sup> (the "B" delay) *should have been* indicated as 75 days.
7. The "A" delay period and the "B" delay period do not overlap (*i.e.*, they do not occur on the same calendar days).
8. The adjustment period is reduced by 57 days due to applicant delay as set forth in CFR §1.704.
9. Based on Wyeth, the correct patent term adjustment should have been indicated as 573 days, the sum of the "A" delay (555 days) and the "B" delay (75 days) minus applicant delay (57 days).
10. The patent is not subject to a terminal disclaimer.

## C. Conclusion

---

1. The Federal Circuit agreed with the District Court and concluded that the only way that periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another, they do not overlap, and CFR §154(b)(2)(A) does not limit the extension to one delay.
2. "The period of adjustment under CFR §1.702(a) is . . . [t]he number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed . . . and ending on the date of mailing of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first." CFR §1.703(a).
3. "The period of adjustment under CFR §1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed." CFR §1.703(b).

Therefore, because the "A" delay period and the "B" delay period do not overlap (*i.e.*, they do not occur on the same calendar days), applicants respectfully request that a Patent Term Adjustment include the "B" delay.

Respectfully submitted,  
/Kerry S. Culpepper/  
January 20, 2010  
Kerry S. Culpepper  
Reg. No. 45,672

Panasonic Patent Center  
1130 Connecticut Ave., NW, Suite 1100  
Washington, D.C. 20036  
Phone: 202-912-3800  
Fax: 202-912-0774  
Customer No. 42212